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EXAMINER

SMITH, PHILIP ROBERT

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/799,795

Applicant(s)

FUJITA, MASAYA

Examiner

Philip R. Smith

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/12/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112, Paragraph One

[01] The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

[02] Claims 4, 7, 10, 12 & 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

[03] Claim 4 recites "an incision mode designating group," identified in Table 1 of the specification as being one of 'urology,' 'mix 1,' 'mix 2,' or 'pure.' These are not conventional terms which enable a skilled artisan to make or use the invention.

[04] Claim 4 additionally recites "a clotting mode designating group," identified in Table 1 of the specification as being one of 'soft' or 'soft A.' These are not conventional terms which enable a skilled artisan to make or use the invention.

[05] Claims 7 and 10 recite "a set fluid amount designating group," identified in Table 1 of the specification as being one of 'up' or 'down.' It is not clear to a skilled artisan what 'fluid amount' is being modified.

[06] Claims 12 & 15 recite "an instruction necessary for checking the setting." It is not

clear to a skilled artisan what device has a setting, or what about the setting must be checked.

Claim Rejections - 35 U.S.C. 112, Paragraph Two

[07] The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

[08] Claims 1-12 & 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

[09] For the reasons set forth above, claims 4, 7 & 10 are indefinite and rejected under 35 U.S.C. 112.

[09a] Note on interpretation: claim 4 recites "an output system designating group," which uses conventional terms [monopolar / bipolar]; and "an incision output designating group" and "a clotting output designating group," both being identified as being either 'up' or 'down.' These directionals, ambiguously specified, presumably refer to the applied voltage.

[10] Claim 1 twice recites "a voice and character converting step." This appears to be a method step; no apparatus is claimed. The recited "voice and character converting step" will be interpreted as if it were an apparatus. Claim 1 additionally recites "the combination of the command character trains," which lacks antecedent basis.

[10a] Claims 2-12 are rejected for incorporating the subject matter of claim 1.

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- [11] Claims 12 & 15 recite "an instruction necessary for checking the setting." This is not conventional terminology, nor is it described in the specification in a way which is enabling to one of ordinary skill.

Claim Rejections - 35 USC § 102

- [12] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- [13] Claims 1-3, 5, 6 & 8-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang (6,911,916), filed 13 July 2000.

- [14] With regard to claim 1: Wang discloses an endoscope system comprising:

[14a] a voice input unit ("microphone 34," 3/35) which inputs voice;

[14b] a voice and character [converter] ("feature extractor 38," 3/38) which recognizes the voice inputted and converts the inputted voice into character data;

[14c] a monitoring unit ("decoder 40," 3/40) which monitors command character trains ("lexicon," 4/39-45) for a plurality of devices ("any electrically controlled device utilized in an operating room environment," 2/60-61) that are hierarchized and are previously stored in a memory ("pre-saved user-

models 41," 3/42) in a system controller ("master controller 12" comprising "voice control interface (VCI) 32," 3/22) for controlling the plurality of devices and the character data that is converted by the voice and character [converter]; and

[14d] an executing unit (comprising "master controller 12" and "slave controller(s) 14," 4/55-59) which executes an instruction ("control commands," 6/15-23) previously allocated to [a] combination of the command character trains, upon detecting, in the converted character data, the command character train from the plurality of command character trains for a predetermined time interval in accordance with the preset hierarchy.

[15] With regard to claims 2, 5 & 8: The plurality of devices disclosed by Wang comprise an electric cautery device ("electrocautery device 18," 2/51) and a gas insufflator ("insufflator 24," 2/58).

[16] With regard to claims 3, 6 & 9: The command character trains include character trains which designate a plurality of output formats ("control commands," as noted above) of the plurality of devices.

[17] With regard to claim 11: Wang discloses that the executing unit executes the instruction ("control commands," as noted above) allocated to the combination of the command character trains and thereafter displays the executed result of the instruction (via "video monitor 86," 8/16).

[18] With regard to claims 12 & 15: Wang discloses an executing unit (as noted above)

which is inherently capable of checking a setting before executing an instruction.

[19] With regard to claim 13: Wang discloses an apparatus (as noted above) with an inherent device control method comprising:

[19a] a voice input step of inputting voice;

[19b] a voice and character converting step of recognizing the voice inputted and converting the inputted voice into character data;

[19c] a monitoring step of monitoring command character trains for a plurality of devices that are hierarchized and are previously stored in a memory in a system controller for controlling a plurality of devices and the character data that is converted by the voice and character converting step; and

[19d] an executing step of executing an instruction previously allocated to the combination of the command character trains, upon detecting, in the converted character data, the command character train from the plurality of command character trains for a predetermined time interval in accordance with the preset hierarchy.

[20] With regard to claim 14: as noted above, Wang discloses a display step of displaying an executed result of the instruction after executing the instruction allocated to the combination of the command character trains in the executing step.

[21] With regard to claim 16: as noted above, Wang discloses an endoscope system comprising one or a plurality of devices, the endoscope system comprising:

- [21a] voice input means which inputs voice;
- [21b] voice and character converting means which recognizes the voice inputted and converts the inputted voice into character data;
- [21c] a system controller which controls the plurality of devices;
- [21d] monitoring means which monitors command character trains for the plurality of devices that are hierarchized and are previously stored in a memory in the system controller and the character data that is converted by the voice and character converting means; and
- [21e] executing means which executes an instruction previously allocated to the combination of the command character trains, upon detecting, in the converted character data, the command character train from the plurality of command character trains for a predetermined time interval in accordance with the preset hierarchy.

Claim Rejections - 35 USC § 103

- [22] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- [23] Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Tvinneriem (2003/0139789), filed 7 November 2002.

- [24] As noted above, Wang discloses "voice control" of "any electrically controlled device utilized in an operating room," including "electrocautery device 18" (2/50-3/30). The voice control disclosed by Wang is broken down into "selection commands," in which a user selects a single device from among a plurality of devices, and "control commands," through which the selected device, for example, an electric cautery device, is controlled.
- [25] Wang does not disclose the specific "control commands" to which the "electrocautery device 18" is responsive. More particularly, Wang does not disclose that the character trains which designate the plurality of output formats of the electric cautery device include an output system designating group [monopolar / bipolar], an incision mode designating group [urology / mix1 / mix2 / pure], an incision output designating group [up / down], a clotting mode designating group [soft / soft A], and a clotting output designating group [up / down].
- [26] Tvinneriem discloses an electric cautery device which is operable in "bipolar and monopolar modes" ([0146]). Tvinneriem additionally discloses that the electric cautery device is operable in "at least two different modes, an ablation mode and a subablation or thermal heating mode," necessitating a "lower voltage" ([0132]).
- [27] Since one of ordinary skill in the art would be expected to turn to the prior art to "fill in the gaps" when reducing the Wang reference to practice, the ordinarily skill artisan would be thus motivated to use what is known in the art of electric cautery devices. Use of such known features with the electric cautery device of Wang would therefore be obvious and involve no inventive effort.

Additional Claim Rejections - 35 USC § 103

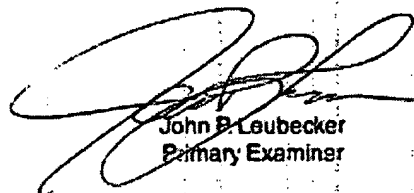
- [28] Claims 7 & 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Kraft-Kivikoski (6,402,714), filed 12 November 1999.
- [29] As noted above, Wang discloses "voice control" of "any electrically controlled device utilized in an operating room," including "insufflator 24" (2/50-3/30). The voice control disclosed by Wang is broken down into "selection commands," in which a user selects a single device from among a plurality of devices, and "control commands," through which the selected device, for example, an electric cautery device, is controlled.
- [30] Wang does not disclose the specific "control commands" to which the "insufflator 24" is responsive. More particularly, Wang does not disclose that the character trains which designate the plurality of output formats of the gas insufflator include an air-supply on/off designating group [start / stop], a set pressure designating group [up / down], an air-supply mode designating group [high / middle / low], and a set fluid amount designating group [up / down].
- [31] Kraft-Kivikoski discloses a gas insufflator which can inherently be started and stopped. Kraft-Kivikoski additionally discloses that the gas insufflator is to regulate pressure and supply air ("pressure regulator 18," 7/27-65).
- [32] Since one of ordinary skill in the art would be expected to turn to the prior art to "fill in the gaps" when reducing the Wang reference to practice, the ordinarily skill artisan would be thus motivated to use what is known in the art of gas insufflators.

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Use of such known features with the gas insufflator of Wang would therefore be obvious and involve no inventive effort.

Conclusion

- [33] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip R. Smith whose telephone number is (571) 272 6087 and whose email address is philip.smith@uspto.gov. The examiner can normally be reached between 9:00am and 5:00pm.
- [34] If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272 4764.
- [35] Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker
Primary Examiner